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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,455	12/13/1999	STEVEN E. GARDELL	96-3-511-CON	2494

32127 7590 10/06/2003

VERIZON CORPORATE SERVICES GROUP INC.
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IRVING, TX 75038

EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/06/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/460,455

Applicant(s)

GARDELL ET AL.

Examiner

Dung Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12-16,18-22,25-28,30-33 and 35-70 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) ____ is/are allowed.

- 6) ☒ Claim(s) 1-4,6-10,12-16,18-22,25-28,30-33 and 35-70 is/are rejected.

- 7) ☐ Claim(s) ____ is/are objected to.

- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

The IDS filed 12/13/1999 (paper#2) did not include a 1449 form listing the references. The references are hereby cited in the attached PTO-892 form.

Specification

The first line of the specification must recite the continuation data including the serial number, patent number and filing date of the parent application. Correction is required.

Claim Rejections - Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-10, 12-16, 18-22, 25-28, 30-33, 35-70 are rejected under the judicially created doctrine of obviousness-

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type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,049,831. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite essentially the same limitations.

Claim 1 of the present application and claim 1 of pat. '831 recited means for receiving a request, means for retrieving first network information, means for creating second network information based on the first network information, the second information comprising display information and definitions based on characteristics of the interactive elements; and means for transmitting the second information.

Claim 1 of present application merely recites means for transmitting. It does not recite the means for transmitting includes transmitting definitions in a first path and display information in a second path as in claim 1 of pat. '831. The functionality of claim 1 does not require separate path for its operation. It would have obvious for one of ordinary skill in the art to leave out element that not essential to the operation of the system.

Similar rationale of rejection applies to independent claims 7, 13, 25, 36, 41, 50, 56, and 66.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-10, 12-16, 18-22, 25-28, 30-33, 36-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis US patent 5,727,159.

As per claim 1, Kikinis teaches an apparatus (proxy server 19) essentially as claimed, comprising:

means for receiving request and means for retrieving first network information having interactive elements [fig.4, #81 - #97];

means for creating second network information comprising display information [images #101] and definitions [layout #99] based on characteristic of the interactive elements [col.7 lines 12-24, 44-55, col.10 lines 56-68];

means for transiting the second information [fig.4 #105].

As per claim 2, Kikinis teaches capture information related to the current session [col.7 lines 12-24].

As per claim 3, Kikinis teaches means accessing the internet [col.4 lines 25-28].

As per claim 4, Kikinis teaches translating the information from first format to second format [fig.4 #99 - #103].

As per claim 6, Kikinis teaches means for receiving user request related to the definition [fig.4 - request to a WEB page 76 - a web page is an HTML encoded file with definition of information to be rendered].

As per claim 46, Kikinis teaches using the captured information in another request [apparent from col.7 lines 12-24 that the proxy remember the setting for a particular PDA in another request].

As per claims 7-10,12,47, 13-16,18-22,48, 25-28,30-33,49, 36-45, 50-69 are rejected under similar rationales as for claims 1,2-4,6 and 46 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis US patent 5,727,159.

As per claim 70, Kikinis does not specifically disclose the network information including MPEG information. However, official notice is taken that it is well known to provide video via MPEG over the Internet. Kikinis discloses providing conversion for multimedia data provided over the Internet [col.6 lines 55-68]. Hence, it would have been obvious for one of ordinary skill in art to have conversion for MPEG so as to enable the client device to view the video data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (703) 305-4792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2100 Customer Service whose telephone number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

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or faxed to:

(703) 872-9306, (for formal communications intended for entry)
(703) 746-7240 (for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington. VA, Fourth Floor (Receptionist).

A handwritten signature in black ink, appearing to read 'Dung Dinh', with a stylized, flowing script.

Dung Dinh
Primary Examiner
September 30, 2003